

## II. REMARKS

### Formal Matters

Claims 42-46, 49, 54-57, and 83-100 are pending after entry of the amendments set forth herein.

Claims 42-46, 49, 54-57, and 83-100 were examined and were rejected. Claims 50-53 and 58-82 were withdrawn from consideration.

Claims 42, 45, 46, 49, 54, 56, 57, 83, 86-88, 90-92, 95-97, 99, and 100 are amended. The amendments to the claims were made solely in the interest of expediting prosecution, and are not to be construed as an acquiescence to any objection or rejection of any claim. Support for the amendments to claim 42, 45, 46, 49, 54, 56, 57, 83, 86-88, 90-92, 95-97, 99, and 100 is found in the claims as originally filed, throughout the specification, and in the Figures. Accordingly, no new matter is added by these amendments.

Claims 50-52 and 58-82 are canceled without prejudice to renewal, without intent to acquiesce to any rejection, and without intent to surrender any subject matter encompassed by the canceled claims. Applicants expressly reserve the right to pursue any canceled subject matter in one or more continuation and/or divisional applications.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

### Rejections and objections withdrawn

Applicants note with gratitude that the following rejections and objections of currently pending claims, raised in the August 27, 2003 Office Action, have been withdrawn: 1) the objection to claim 49; 2) the rejection of claims 42-46, 49, and 54-57 under 35 U.S.C. §112, first paragraph (written description); 3) the rejection of claims 42-46, 49, and 54-57 under 35 U.S.C. §112, second paragraph; and 4) the rejection of claims 42-46 and 54 under 35 U.S.C. §102(b).

### Rejection under 35 U.S.C. §112, first paragraph

Claims 42-46, 49, 54-47, and 83-100 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 42-46, 49, 54-47, and 83-100 were rejected under 35 U.S.C. §112, first paragraph, as allegedly reciting new matter.

Written description

The Office Action stated that the claims need to recite less than *the* AT content of *the* corresponding naturally occurring nucleotide sequence encoding *the* gp190/MSP-1 protein.

Without conceding as to the correctness of this rejection, claims 42, 83, and 92 are amended to recite “wherein the adenine and thymine (AT) content of the expressed nucleotide sequence encoding the MSP-1 protein is less than the AT content of the corresponding naturally occurring nucleotide sequence encoding the MSP-1 protein.” Applicants thank the Examiner for the helpful suggestions for claim language, as provided on page 6 of the Office Action.

“New matter”

The Office Action stated that the specification fails to provide proper antecedent basis for the phrase “having an approximate weight of 190 kD.”

Without conceding as to the correctness of this rejection, and solely in the interest of expediting prosecution, claims 42, 83, and 92 are amended to recite “wherein the MSP-1 protein has a molecular weight in the range of from 190 kD to 220 kD.” Applicants submit that such claim language adequately addresses this rejection.

Conclusion as to the rejections under 35 U.S.C. §112, first paragraph

Applicants submit that the rejection of claims 42-46, 49, 54-47, and 83-100 under 35 U.S.C. §112, first paragraph, has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

Rejection under 35 U.S.C. §112, second paragraph

Claims 42-46, 49, 54-57, and 83-100 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite.

The Office Action stated that the claims are indefinite because they compare two sequences wherein the naturally occurring sequence is not structurally defined, and recites “a” as in any naturally occurring form and not the naturally occurring form from which it is derived.

As noted above, and without conceding as to the correctness of this rejection, claims 42, 83, and 92 are amended to recite “wherein the adenine and thymine (AT) content of the expressed nucleotide sequence encoding the MSP-1 protein is less than the AT content of **the** corresponding naturally occurring nucleotide sequence encoding the MSP-1 protein.” Applicants submit that such language suffices to adequately address the rejection.

As to claims 46, 87, 88, 91, 96, 97, 98, 99, and 100, the Office Action suggested recitation of “the expressed nucleotide sequence.”

Claims 46, 87, 88, 91, 96, 97, 98, 99, and 100 are amended to recite “**the expressed** nucleotide sequence,” as suggested in the Office Action.

Applicants submit that the rejection of claims 42-46, 49, 54-57, and 83-100 under 35 U.S.C. §112, second paragraph, has been adequately addressed in view of the remarks set forth above. The Examiner is thus respectfully requested to withdraw the rejection.

**Allowable subject matter**

Applicants thank the Examiner for the helpful suggestion for claim language that would be deemed allowable. The above-noted amendments to the claims take the Examiner’s suggestions into account.

### III. CONCLUSION

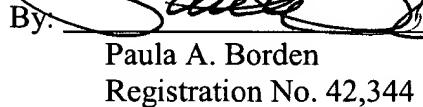
Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number GRUE003.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: May 26, 2004



By:   
Paula A. Borden  
Registration No. 42,344

BOZICEVIC, FIELD & FRANCIS LLP  
200 Middlefield Road, Suite 200  
Menlo Park, CA 94025  
Telephone: (650) 327-3400  
Facsimile: (650) 327-3231